

REMARKS

Claims 1-2 and 4-21 are currently pending in the application, wherein claims 1-2 and 4-21 have been rejected. With this amendment, new claims 22-24 have been added and their examination is respectfully requested.

As a preliminary matter, Applicant requests consideration of the Information Disclosure Statement filed on May 2, 2003 and requests a copy of the initialed Form PTO-1449 confirming consideration of the same IDS with the next paper from the Examiner.

In the Final Office Action dated March 3, 2003, claims 1, 2, 8 and 9 were rejected under 35 U.S.C. §102(b) as being anticipated by Truckai (U.S. Patent No. 5,019,057). Applicant respectfully traverses this rejection. In order to anticipate, the reference must disclose each and every element of the claimed invention.

Independent claims 1 and 8 each recite a second wire comprising a highly radiopaque metal. Truckai discloses a helically wound steel wire. In supporting the rejection in the Final Office Action, the Examiner states, "Since stainless steel is more radiopaque than some materials, such as nitinol, it is considered to meet the limitation of *highly radiopaque*."

During patent examination, the pending claims must be given their broadest reasonable interpretation consistent with the specification. The Examiner must take into account whatever enlightenment by way of definitions or otherwise that may be afforded by the written description contained in the applicant's specification. See M.P.E.P. §2111. In this instance, the Examiner has failed to interpret the claims in view of the specification as required during prosecution. The specification of the current application at page 1, lines 10-13 states:

Intravascular catheter shafts commonly incorporate a reinforcement layer such as a stainless steel wire braid to enhance the strength of the shaft. Generally speaking, however, *stainless steel wire braid is not highly radiopaque*, and therefore is not highly visible using conventional x-ray radiographic visualization techniques. (emphasis added).

Applicant has defined highly radiopaque metals to expressly not include stainless steel. Therefore, the Examiner's reliance on the steel wire taught by Truckai as teaching a highly radiopaque metal wire is inconsistent with the definition provided in the current application.

Additionally, the broadest reasonable interpretation applied to the claims must be consistent with the interpretation that those skilled in the art would reach. *See* M.P.E.P. §2111. Applicant asserts that the Examiner's interpretation of the claim language is inconsistent with the interpretation that those skilled in the art would reach. Applicant has previously submitted numerous references indicating that stainless steel is not considered highly radiopaque by those skilled in the art. Applicant requests the Examiner's attention be drawn to Applicant's remarks dated May 2, 2003, as those remarks are herein incorporated by reference. The Examiner is required to interpret the claims in view of the interpretation given the claims by one skilled in the art, not from a withdrawn viewpoint.

Applicant asserts that, consistent with what is disclosed in the specification and the interpretation by one skilled in the art, stainless steel is not highly radiopaque. Therefore, the Examiner's reliance on the teachings of Truckai as teaching a highly radiopaque metal wire is incorrect in light of the specification of the current application and of those skilled in the art.

Applicant submits that Truckai does not anticipate that which is claimed in claims 1 and 8 because Truckai does not include a wire made from a highly radiopaque metal. Applicant respectfully asserts that these claims are in condition for allowance. Claims 2 and 9 depend from claims 1 and 8, respectively, and contain significant additional elements. Therefore, Applicant respectfully asserts that these claims are also in condition for allowance.

In the Final Office Action, claims 1-2 and 4-18 were rejected under 35 U.S.C. §103(a) as being unpatentable over Sater et al. (U.S. Patent No. 6,068,622) in view of Truckai. Applicants respectfully traverse this rejection.

Sater et al. fail to teach a highly radiopaque metal wire as claimed in claims 1, 8 and 14. Sater et al. teach wire filaments such as stainless steel, nitinol, or polymeric fibers. As discussed above, stainless steel is not considered to be highly radiopaque to those skilled in the art, and the current application defines highly radiopaque as not including stainless steel. Additionally, the Examiner asserts that stainless steel is more radiopaque than a polymer or a nitinol. *See* Advisory Action. Therefore, if stainless steel is not highly radiopaque, nitinol necessarily cannot be considered highly radiopaque. As stated above, Truckai also fails to teach a highly radiopaque metal wire. Because neither Sater et al. nor Truckai teach a highly radiopaque metal wire, claims 1, 8 and 14 are believed to be in condition for allowance. Claims 2 and 3-7 depend from claim 1 and contain significant additional elements, claims 9-13 depend from claim 8 and

contain significant additional elements, and claims 15-18 depend from claim 14 and contain significant additional elements. Therefore, these claims are also believed to be in condition for allowance.

In the Final Office Action, claims 19 and 20 were rejected under 35 U.S.C. §103(a) as being unpatentable over Truckai in view of Chien et al. (U.S. Patent No. 6,165,163). Claim 21 was rejected under 35 U.S.C. §103(a) as being unpatentable over Truckai in view of Sater et al. and further in view of Chien et al. Applicant respectfully traverses these rejections.

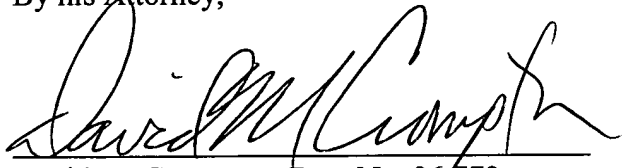
As these claims depend, directly or indirectly, from an independent base claim, namely claim 1, 8 or 14, and contain significant additional elements, Applicant submits that these claims are also in condition for allowance.

Reexamination and reconsideration of all pending claims and newly presented claims is respectfully requested. Applicant believes all claims are in condition for allowance and issuance of a Notice of Allowance in due course is anticipated. If a telephone conference may be of assistance, please contact the undersigned attorney at (612) 677-9050.

Respectfully submitted,

Henry J. Pepin

By his Attorney,



David M. Crompton, Reg. No. 36,772  
CROMPTON, SEAGER & TUFTE, LLC  
1221 Nicollet Avenue, Suite 800  
Minneapolis, MN 55403-2420  
Telephone: (612) 677-9050  
Facsimile: (612) 359-9349

Date: 8/21/03